

Appl. No. 10/759,861
Amdt. Dated 6-20-06
Reply to Office Action of 3-20-06

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application. Applicant has rewritten dependent claim 2 into independent form so that the container is included in the broadest claim.

Amended Claims are Patentable

Should the examiner find applicant's arguments unpersuasive, applicant respectfully submits the following newly claimed recitations clearly place the present invention in condition for allowance.

Applicant has amended the claims to more narrowly distinguish the present invention over the prior art of record. Applicant respectfully submits no new matter has been introduced, which would affect the statutory requirements of patentability, because all newly claimed recitations are clearly supported by the original drawings. A person of ordinary skill in the art is enabled to make and use the presently claimed invention based on the originally filed drawings. Applicant has included case law, wherein the Court has held the claims may be amended based upon the originally filed drawings without triggering a new matter rejection (please see attached literature).

Regarding the Independent Claims

- *a plurality of unitary sockets having single bodies.* The examiner has equated Lin's elements 1, 5 and 6 to applicant's claimed sockets. Applicant's sockets are now claimed as being unitary and having single bodies, which are not taught by Lin's combination of elements 1, 5 and 6.

- *a first shank having a square end portion for selectively receiving said plurality of sockets therein.* Lin's first shank 4, as defined by the examiner, does not have a square end portion (see FIG. 1). Rather, Lin's first shank 4 is necessarily and inherently threaded to attach to threaded hole 61 as shown in FIG. 1.

- *said second shank having a hexagonal shape and being removably attached to a tool so that same can rotatably engaged with an interior of a pipe and thereby clean*

Appl. No. 10/759,861
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same. Lin's wire brush 3, as defined by the examiner, does not having a second shank that is removably attached to a tool, as claimed by the applicant.

- *said lower end portion of said wire brush being disposed on top of said second shank such that said lower end portion of said wire brush remains spaced from the tool during operating conditions;* Lin's lower end portion 33 is not disposed on top of its second shank 31, as defined by the examiner (see FIG. 1). Lin's lower end portion 33 is necessarily and critically connected directly to the tool (T) during operating conditions (see FIG. 4) so that its wire brush 3 can rotate.

- *wherein each of said sockets are independently attached to said first shank such that only one of said sockets is attached to said shank during operating conditions;* Lin necessarily and inherently teaches more than one of its sockets 1, 5 and 6, as defined by the examiner, attached to its first shank 4 (see FIG. 1). Such sockets 1, 5 and 6 are not independently attached to its tool (T).

- *wherein a bottom one of said openings of said sockets has a square shape mated with said first end portion of said first shank.* Lin's bottom opening 11 of its socket 1 necessarily and inherently has an annular shape (see FIG. 1).

- *wherein a top one of said openings of said sockets has a diameter greater than a width of said bottom opening, said top opening terminating at said bottom opening such that said top and bottom openings are not in fluid communication with each other.* Lin's top and bottom openings do not having the structural characteristics as specifically claimed by the applicant (see FIGS. 2 -5).

- *wherein said second shank is medially seated between said lower end portion of said wire brush and the tool.* Lin's second shank 33, as defined by the examiner, is necessarily and critically seated above its lower end portion 31 and tool T, in contrast to applicant's claimed second shank.

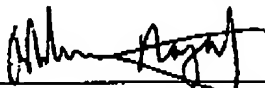
In view of these considerations, it is respectfully submitted that the rejection of the pending claims should be considered as no longer tenable with respect to the above mentioned claim amendments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

Appl. No. 10/759,861
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Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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1068

Patent Prosecution

Ch. 8.IV.B

for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the latter are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.⁴⁹²

The CCPA remarked that the originally filed specification described the step of applying the adhesive as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums."⁴⁹³ The specification thus described one method of adheringly applying the various layers in the thermal insulation. On the basis of this description, the CCPA held that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered. Thus the phrase 'adheringly applying' is supported by the example found in the specification."⁴⁹⁴

Rasmussen therefore teaches that an original claim and examples in the specification may be used to support amendments after the application is filed.

* C. Drawings That Provide Support for Amendments to Specification

Drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. *In re Wolfensperger*⁴⁹⁵ is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In *Wolfensperger*, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a "packing ring" in "untensioned condition" that included "a mean diameter corresponding approximately to the mean diameter of said chamber."⁴⁹⁶

On appeal, the CCPA reversed. The court disagreed with the Board's statement that it was well-established legal precedent that

⁴⁹²*Id.*, 211 USPQ at 326 n.5 (citing *In re Anderson*, 471 F.2d 1237, 1238, 176 USPQ 331, 332 (C.C.P.A. 1973)).

⁴⁹³*Id.*, 211 USPQ at 326.

⁴⁹⁴*Id.*, 211 USPQ at 327 (footnote omitted) (emphasis in original).

⁴⁹⁵*In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962).

⁴⁹⁶*Id.*, 133 USPQ at 538.

Ch. 8.IV.D

Disclosure

1069

drawings alone cannot constitute a written description of the invention. The CCPA stated as follows in this connection:

Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case.⁴⁹⁷

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."⁴⁹⁸

The CCPA held that figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber.⁴⁹⁹ On this basis, the court held that the application satisfied the written description requirement. Thus, *Wolfensperger* teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.

D. New Matter and Correcting Obvious Errors

An applicant may generally correct obvious errors in the application without introducing prohibitory new matter. For example, translation errors from foreign prior applications may generally be corrected.⁵⁰⁰ The general rule is that if the error can be detected and corrected by one of ordinary skill in the art, then the applicant may amend the application to correct the error without introducing new matter.⁵⁰¹

*Ex parte Brodbeck*⁵⁰² is an example of when an applicant was permitted to amend the specification to correct an obvious error. In *Brodbeck*, the invention related to a process of catalytic isomerization of a compound. Brodbeck sought to reissue his already-granted patent, U.S. Patent Number 3,647,898, by amending the claim portion of the application. The original claim 1 of the issued patent recited the lim-

⁴⁹⁷*Id.*, 133 USPQ at 541-42.

⁴⁹⁸*Id.*, 133 USPQ at 542 (emphasis in original).

⁴⁹⁹*Id.*, 133 USPQ at 541.

⁵⁰⁰See *In re Oda*, 443 F.2d 1200, 170 USPQ 268, 272 (C.C.P.A. 1971).

⁵⁰¹*Id.*

⁵⁰²*Ex parte Brodbeck*, 199 USPQ 230 (Pat. Off. Bd. App. 1977).